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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,026	04/10/2001	Gary Helms	108298613US	8349

25096 7590 01/29/2007  
PERKINS COIE LLP  
PATENT-SEA  
P.O. BOX 1247  
SEATTLE, WA 98111-1247

EXAMINER
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PLUCINSKI, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/29/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/833,026

Applicant(s)

HELMS ET AL.

Examiner

Jamisue A. Plucinski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 and 21-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. In response to Amendment filed 10/16/06
2. Claims 1-19 and 21-36 are pending

#### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. With respect to Claims 14-16: The applicant states in the preamble of the claims that the invention is drawn to a system. However, in the body of the claim language, instead of the limitations being written as system limitations, they are written as method steps. Therefore, causing to be unclear which statutory class the invention falls into.

#### *Claim Rejections - 35 USC § 101*

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. 35 U.S.C. 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or

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any new and useful improvement thereof” (emphasis added). Applicant’s claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 USC 101. The claims begin by discussing a system (the preamble in claims 14-16 as well as independent claim 11) while the body of the claim does not provide any system limitations, but rather attempts to positive claim method steps.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-3, 7, 8, 10, 12, 17, 18, 22-24, 28, 29, and 31-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Hsuan (2002/0116240).

9. With respect to Claims 1, 11, 22, 32 and 36: Hsuan discloses the use of a method, with computer instructions and system with means for tracking orders or multiple unites of items (see abstract) comprising the means for performing the steps:

- a. Providing an order database (90, with corresponding detailed description) with an order record for a plurality of items;
- b. Creating a unit order database (80, article database, with corresponding detailed description) having a record for each unit with a unique article identifier, and a link to the order database (see abstract and paragraph 0038); and

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- c. Setting a status of each unit of each order, when the status changes with the order (see abstract, and Figures 11 and 12 with corresponding detailed description). The examiner considers changes in the order database, to include changes such as tracking.
10. With respect to Claims 2, 12, 23, 33 and 36: See Hsuan, abstract.
11. With respect to Claims 3, 13, 24 and 34: See Hsuan, abstract, and paragraph 0039.
12. With respect to Claims 7, 17 and 28: Hsuan discloses the updating of the status of the orders are done on a continuous basis (paragraphs 0037 and 0043), which the examiner considers to be a periodic basis.
13. With respect to Claims 8, 18 and 29: The order of Hsuan are tracked on a continuous basis, therefore the examiner considers this to be multiple times a day, which the examiner considers to be done on a daily basis because it is done every day.
14. With respect to Claims 10 and 31: See Hsuan, abstract and paragraph 0038.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 9, 19 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsuan (US 2002/0116240).

17. Hsuan discloses setting a status in the record, however fails to disclose the status being a shipping status, and ship date. However, the specific type of information that the status is based on is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The creating of database steps and updating status steps would be performed the same regardless of what type of information the status is based on, the claims merely store this information, not use the ship date in any particular fashion, or in any further steps.. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

18. Claims 4-6, 13-16, 21, 25-27 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsuan as applied to claims 1, 11, 22 and 32 above, and further in view of Peachey-Kountz et al. (6,463,345).

19. With respect to Claims 4-6, 13-16, 21, 25-27 and 35: Hsuan discloses the use of an order and having a record for each item in an order, but fail to disclose the order can be modified to increase or decrease the quantity of the order, and either adding a unit record or setting a record to cancelled. Peachey-Kountz discloses the use of orders where the quantity of items are changed and modified due to backorders or cancellation of orders (see Figures 5-7, Column 11, lines 53-67), and the record status is updated to reflect the change, (see Figures 5 and 6 with corresponding detailed description). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hsuan, to include the capability of changing

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the order, and the records reflecting the change, in order to provide an improved reporting system. (See Peachey-Kountz, Column 9)

### *Response to Arguments*

20. Applicant's arguments with respect to claims 1-19 and 21-36 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

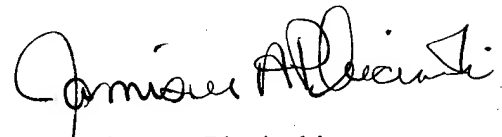
21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wilson et al. (US 2002/0133387) discloses the use of a system with ordering and fulfillment databases, Cazemier et al. (6,609,123) discloses the use of a query engine for accessing multiple layers of information, Green et al. (WO 97/29445) discloses the use of a purchase order system with a separate item database.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Plucinski whose telephone number is (571) 272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jamisue A. Plucinski  
Patent Examiner  
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